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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/848,439	05/08/1997	EDWARD LAVALLIE	GI5288A	2750

22852 7590 06/07/2002

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

UNGAR, SUSAN NMN

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 06/07/2002

20

Please find below and/or attached an Office communication concerning this application or proceeding.

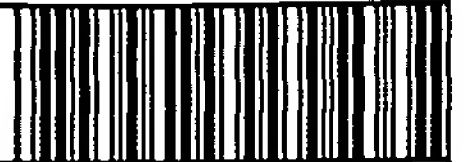
Advisory Action

Application No.
08/848,439

Applicant(s)
La Vallie et al

Examiner
Ungar

Art Unit
1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Apr 10, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Apr 10, 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none

Claim(s) objected to: none

Claim(s) rejected: 1-17

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).

10. ☐ Other: _____

SUSAN UNGAR, PH.D.
PRIMARY EXAMINER

Art Unit: 1642

1. The Response filed April 10, 2002 (Paper No. 27) in response to the Office Action of October 10, 2001 (Paper No. 25) is acknowledged and has been entered. Claims 1-17 are currently being examined.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The following rejections are maintained:

Claim Rejections - 35 USC § 101

4. Claims 1-17 remain rejected for the reasons previously set forth in paper No. 20, Section 5, pages 2-6 and in Paper No.24, Section 5, pages 2-5.

Applicant argues that (a) the PTO is required to establish that it is more likely than not that a person skilled in the art would not consider credible any specific utility in order to establish a *prima facie* case of unpatentability, (b) Applicant reiterates arguments drawn to providing the sequences of SDF-5, art-recognized credible uses of SDF-5, (c) Applicant reiterates arguments drawn to Examiner's recognition that the protein encoded by SEQ ID NO:1 may be capable of binding Wnt protein and may be capable of regulating the interaction of Wnt genes, (d) the potential signal transduction regulation activities of these proteins along with the presence and/or expression of Wnt genes suggests that human SDF-5 is an important regulator of differentiation of tissues and organs (e) Applicant reiterates arguments drawn to activity assays of SDF-5.

The argument has been considered but has not been found persuasive because (a') of the reasons previously set forth which clearly set forth a *prima facie* case for unpatentability under 35 USC 101, (b') the arguments are not persuasive for the

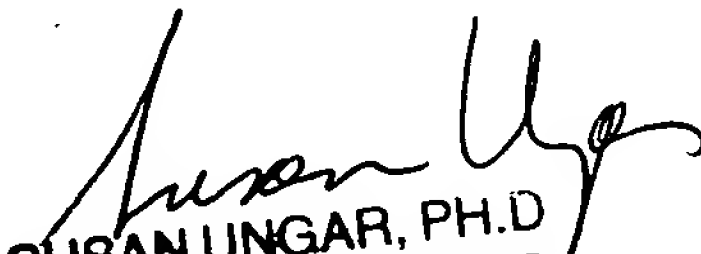
Art Unit: 1642

reasons previously set forth, (c') the arguments are not persuasive for the reasons previously set forth, (d') although signal transduction activities are found in some Frizzled receptor proteins, Applicant clearly admits on the record that this activity is only potential for the protein encoded by SEQ ID NO:1, SEQ ID NO:2, thus the suggested activity is not well established and the activity is not substantial because it requires further work to identify a real-world use for the claimed invention, (e') the arguments are not persuasive for the reasons previously set forth. Applicant's arguments have not been found persuasive and the rejection is maintained.

Claim Rejections - 35 USC § 112

5. Claims 1-17 remain rejected under 35 USC 112, first paragraph for the reasons previously set forth in Paper No. 20, Section 7, page 6 and Paper No. No.24, Section 6, page 5.

Applicant argues that for the reasons set forth above, the claimed invention has utility and therefore one skilled in the art would know how to use the claimed invention. The argument has been considered but has not been found persuasive for the reasons set forth above. Applicant's arguments have not been found persuasive and the rejection is maintained.


SUSAN UNGAR, PH.D.
PRIMARY EXAMINER